

REMARKS

Claims 10, 2-5, and 6-8 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. In this rejection, the Examiner has stated that the claims contain subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner has stated that the claim terminology "lubricant dragging bore relief" was not described in the original disclosure of the application.

In response thereto, the Applicants submit that this claim language is, in fact, supported by the original specification. Specifically, in the last paragraph on page 3, it is stated "...the inner surface has several lubrication bore reliefs formed as recesses...". In addition, there is stated beginning in the last paragraph on page 3: "Due to a relative motion of the moved and stationary machine part, small amounts of hydraulic liquid are dragged from the high-pressure region into the low-pressure region." Thus, support is provided for terminology "liquid dragging bore release".

The Applicants submit that an originally filed application that reasonably conveys to those skilled in the relevant art that the Applicants, as of the filing date of the original application, had possession of the claimed invention, satisfies the written description requirement of

35 USC 112, first paragraph. *In re Alton*, 37 USPQ 2d 1578 (Fed. Cir. 1996); *In re Kaslow*, 217 USPQ 1089 (Fed. Cir. 1983).

In order for the Examiner to reject the claims under the enablement requirement under 35 USC 112, first paragraph, the Examiner must present evidence of reasons why the specification does not teach those skilled in the art how to make and use the full scope of the claimed invention without "undue experimentation". *In re Wright*, 27 USPQ 2d 1510 (Fed. Cir. 1993).

In the case at hand, the Applicants have provided in the original specification beginning on page 3, last paragraph, sufficient description. It has been held that the function of the description requirement is to insure that the inventor has possession, as of the filing date of the application relied upon, of a specific subject matter later claimed by him. How the specification accomplishes this is not material. Claimed subject matter may not be described in Haeck Verba to satisfy a description requirement, it is not necessary that the application describe limitations exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure what the applicants have invented. See *In re Hershler*, 200 USPQ 711 (CCPA 1979).

As set forth in *In re Smith and Hubin*, 176 USPQ 620 (CCPA 1973), compliance with the first paragraph of section 112 is adjudged from the perspective of a person skilled in the relevant art. The specification as originally filed must convey clearly to those skilled in the art the

information that the Applicants have invented the subject matter claimed. When the original specification accomplishes this, regardless as how this is accomplished, the essential goal of the description requirement under 35 USC 112 is realized. See also *In re Smythe*, 176 USPQ 279.

Under this criteria, the Applicants submit that "liquid dragging bore relief" is sufficiently described in the original disclosure and respectfully requests the Examiner to withdraw this rejection.

The Examiner has rejected claims 2-3, 5 and 8 under 35 USC 103(a) as being unpatentable over U.S. 5,127,661 to Franson, et al. in view of U.S. 3,497,225 to Workman.

It is clear that neither Franson, et al. or Workman do not teach and further do not suggest the placement of recesses of the inner surface spaced apart from the movable machine part as presently claimed. The inventive sealing arrangement in accordance with the present invention provides for a sealing lip having better sealing properties in a low pressurized state, thus the recesses and contact with the surface of the movable machine part to drag back liquid only after having applied pressure. Thus, the sealing properties are optimized in both states, namely the unpressurized low-pressure state and the pressurized high-pressure state.

Accordingly, the structure of the present invention provides for optimization of sealing properties not provided by Franson, et al. or Workman. The Applicants further reiterate the arguments presented traversing the

rejection of these claims in view of Franson, et al. and Workman in the amendment filed on May 21, 2009.

Claims 4 and 6-7 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Franson, et al. and Workman as applied to claims 10, 2-3, 5, and 8, and further in view of U.S. 3,189,359 to Haberkorn.

In this rejection, the Examiner acknowledges that Franson, et al. and Workman fail to disclose that the outer and inner surface near the abutment surfaces convex and therefore looks to Haberkorn for teaching of a sealing having a U-shaped with an abutment surface (12) and an inner surface and outer surface (21 and 22) adjacent to the abutment surface that are convex like circular arc (the surface 22 and 21 are convex).

The Examiner concludes it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the outer and inner surface of Franson, et al. and Workman to be convex as taught by Haberkorn to provide proper sealing under high pressure.

In traverse of this rejection, the Applicant submits that Haberkorn fails to teach the essentials of the invention and further in view of the fact that the independent claim is not obvious under 35 USC 103, any claim depending therefrom is non-obvious. *In re Fine*, 5 USPQ 2d 1596 (Fed. Cir. 1989).

In view of the arguments hereinabove set forth and amendment to the claims, it is submitted that each of the

claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



Walter A. Hackler, Reg. No. 27,792
Attorney of Record
2372 S.E. Bristol, Suite B
Newport Beach, California 92660
Tel: (949) 851-5010
Fax: (949) 752-1925